

Remarks

This Application has been carefully reviewed in light of the Office Action mailed April 9, 2008. Applicants believe all claims are allowable without amendment and respectfully provide the following remarks. Applicants respectfully request reconsideration and allowance of all pending claims.

I. The Claims are Allowable Under 35 U.S.C. § 103(a)

A. Independent Claims 1 and 24 and Their Dependent Claims are Allowable over *Northcutt*

The Examiner rejects Claims 1-11 and 24-34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0126001 by Northcutt et al. ("*Northcutt*"). Applicants respectfully traverse these rejections.¹

At a minimum, *Northcutt* fails to disclose, teach, or suggest the following limitations recited in Claim 1:

- a dispatcher operable to . . . automatically determine if any of the plurality of [received] messages is associated with a work assignment; and
- an active work server . . . operable to:
 - receive work information associated with at least one message determined automatically by the dispatcher to be associated with a work assignment;
 - automatically create, in response to receiving the work information associated with at least one message determined by the dispatcher to be associated with a work assignment, a work item associated with the at least one message based at least in part upon the work information associated with at least one message determined by the dispatcher to be associated with a work assignment, wherein the work item comprises an owner identifier; and
 - automatically communicate the work item to an owner associated with the owner identifier.

For example, *Northcutt* fails to disclose, teach, or suggest an active work server that is

¹ Applicants reiterate their belief that they could antedate *Northcutt* based at least on Applicants' date of conception prior to December 28, 2001 (the filing date of *Northcutt*) and subsequent diligence up to the February 8, 2002 filing date of the Application. While Applicants have chosen not to do so in the present Response due to the clear distinctions between Applicants' independent claims and *Northcutt*, Applicants reserve the right to antedate *Northcutt* in a future Response or on Appeal, if appropriate. By not antedating *Northcutt* at this time, Applicants do not concede that *Northcutt* qualifies as prior art.

operable to “automatically create, in response to receiving the work information associated with at least one message determined by the dispatcher to be associated with a work assignment, a work item associated with the at least one message based at least in part upon the work information associated with at least one message determined by the dispatcher to be associated with a work assignment, wherein the work item comprises an owner identifier” as recited in Claim 1.

The Examiner continues to cite paragraph 65 of *Northcutt* as allegedly disclosing these limitations, particularly referencing *Northcutt's* disclosure that “a manager assigns the work item to a person responsible to complete the work assignment.” (See Office Action at 4 and 12) Assuming for the sake of argument that the Examiner's characterization of *Northcutt* is accurate, a manager manually assigning a received request for service to responsible information technology personnel (See *Northcutt*, ¶ 65) does not disclose, teach, or suggest an active work server that is operable to perform the above-cited limitations.

Northcutt discloses that through general reports module 214, a user may select a link to display a listing of all unassigned requests for service. According to *Northcutt*, through this link, the system presents a list of requests for service (e.g., all RFS's) for which no information technology personnel has yet been assigned. (*Northcutt*, ¶ 0058) This portion of *Northcutt* appears to confirm that RFSs in *Northcutt's* system are received and simply sit idle until a manager manually reviews and assigns them to information technology personnel.

Applicants maintain that the cited portions of *Northcutt* fail to disclose, teach, or suggest a distinct work item that comprises an owner identifier indicating an owner of the work item. The Examiner states that the “RFS is the work assignment and the creation of a RFS assigned to a technician is the work item.” (Office Action at 4) Applicants reiterate that the “work item” is an electronic, physical thing that is “created” in response to receiving the work information associated with at least one message that the dispatcher has determined to be associated with a work assignment. Applicants previously amended Claim 1 to make this

clearer.² Simply assigning an RFS to a technician does not disclose, teach, or suggest the creation of the type of physical, electronic work item that is recited in Claim 1.

Moreover, the work item recited in Claim 1 is clearly distinguishable from the RFS assigned to the technology person in *Northcutt*. The RFS is not an electronic, physical thing automatically created “in response to receiving the work information associated with at least one message determined automatically by the dispatcher to be associated with a work assignment” and is not created “based at least in part upon the work information associated with at least one message determined by the dispatcher to be associated with a work assignment,” as recited in Claim 1. Additionally, the Examiner argues that the technology person is the owner of the RFS. (Office Action at 5) Whether or not true (and again Applicants do not concede that an RFS assigned to a technology person can be equated with the work item recited in Claim 1), *Northcutt* still would fail to disclose the creation of an electronic, physical work item that actually comprises an owner identifier.

As another example, at least because *Northcutt* fails to disclose, teach, or suggest the work item recited in Claim 1, *Northcutt* necessarily fails to disclose, teach, or suggest an active work server that is operable to “automatically communicate the work item to an owner associated with the owner identifier,” as recited in Claim 1.

As another example, the Examiner correctly acknowledges that *Northcutt* fails to teach a dispatcher operable to “determine if any of the plurality of messages is associated with a work assignment,” as recited in Claim 1. (Office Action at 13) However, the Examiner argues the following:

It is old and well-known in the art to ‘determine if any of a plurality of messages is associated with a work assignment.’ The advantage of this feature is that it enables the proper organization of information in that the appropriate personnel are associated with the appropriate information. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to combine the feature to ‘determine if any of the plurality of

² The Examiner states that “Applicants distinguish a work item and a work assignment by defining a work item to be created as work to be performed, whereas a work assignment is work that is requested. (Office Action at 4) Applicants do not acquiesce to these definitions of “work assignment” and “work item.” Applicants refer to their discussion on pages 9-10 of the Response mailed October 31, 2007, which more accurately discuss the distinctions between a work assignment and a work item.

messages is associated with a work assignment' with the Northcutt et al. system in order to facilitate the proper management of information, which is a goal of Northcutt et al. (see ¶ 2).

(Office Action at 13)

Applicants maintain that the Examiner provides no evidence for the Examiner's assertion that "[i]t is old and well-known in the art to 'determine if any of a plurality of messages is associated with a work assignment.'" (Office Action at 13) Applicants have repeatedly requested that if "common knowledge" or "well known" art is being relied on to modify the reference, or if Official Notice is being taken, the Examiner provide a reference in support of this position pursuant to M.P.E.P. ch. 2144.03.

The Examiner continues to insist that Applicants somehow have admitted that a dispatcher operable to "determine if any of the plurality of messages is associated with a work assignment," as recited in Claim 1, is prior art. (Office Action at 5-6) Respectfully, Applicants maintain that the Examiner's position is misguided.

First, Applicants respectfully disagree that their traversal of the Examiner's taking of Official Notice was inadequate and certainly do not admit that the limitation "determine if any of a plurality of messages is associated with a work assignment" is prior art.

Applicants again note that the case cited in the M.P.E.P. as allegedly supporting the requirement that applicants state why the noticed fact is not considered to be common knowledge or well-known in the art actually does not support such a requirement. *See* M.P.E.P. ch. 2144.03(C) citing *Chevenard*, 139 F.2d at 713, 60 U.S.P.Q. at 241. Rather, the Court stated, "In the absence of anything in the record to contradict the examiner's holding, ***and in the absence of any demand by appellant for the examiner to produce authority for his statement***, we will not consider this contention." *In re Chevenard*, 139 F.2d 711, 713, 60 U.S.P.Q. 239, 241 (C.C.P.A. 1943). Applicants clearly made such a demand (repeatedly) in this case. **The Examiner has not addressed Applicants arguments regarding *Chevenard*.**

According to the M.P.E.P., “the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute.’” M.P.E.P. ch. 2144.03(A) (Rev. 1, Feb. 2003). The M.P.E.P. continues:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.

Id. (emphasis in original). Furthermore, “[i]f such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” M.P.E.P. ch. 2144.03(B) (Rev. 1, Feb. 2003). The M.P.E.P. also states that, “[i]f applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.” M.P.E.P. ch. 2144.03(C) (Rev. 1, Feb. 2003).

Applicants again submit that the Examiner cannot properly take Official Notice that a dispatcher operable to “determine if any of the plurality of messages is associated with a work assignment,” as recited in Claim 1 is “old and well known.” The Examiner has asserted that these limitations were old and well known at the time of invention without “provid[ing] specific factual findings predicated on sound technical and scientific reasoning to support [the Examiner’s] conclusion of common knowledge,” as the M.P.E.P. requires. In addition, the Examiner’s assertion that the above limitations were old and well known at the time of invention is hardly “capable of such instant and unquestionable demonstration as to defy dispute,” as the M.P.E.P. further requires. Accordingly, Applicants respectfully submit that the Examiner has improperly taken Official Notice that the above limitations were old and well known at the time of invention and respectfully requests that the Examiner withdraw the rejection of the independent claims. If the Examiner intends to maintain this rejection, Applicants again respectfully request that the Examiner at least provide documentary evidence that the above limitations were old and well known at the time of invention, as the Examiner asserts. Moreover, Applicants have not made a “broad request for references,” as asserted by the Examiner. Instead, Applicants have made a specific request for evidence that

the specific limitation identified by the Examiner as being old and well known in actually old and well known.³

Moreover, even assuming for the sake of argument only that the Official Notice was proper, Applicants maintain that the Examiner has not provided an adequate reason to modify *Northcutt* in the manner proposed by the Examiner.

The Examiner has stated that *Northcutt* “sets to solve the problem of properly managing information (see *Northcutt* paragraph 2), thereby providing the requisite motivation to modify *Northcutt* in a manner to facilitate the proper management of information.” (Final Office Action at 5; *see also* Office Action at 7) First, paragraph 2 of *Northcutt* actually states the importance of resource management and discusses workflow management and information technology tasks, rather than some broad “information management” problem. Second, it is not even clear why a goal of information management would lead one of ordinary skill in the art at the time of Applicants’ invention to modify the system disclosed in *Northcutt* to determine if any of the plurality of messages is associated with a work assignment, as asserted by the Examiner.

The Examiner acknowledges that he has proposed an alleged advantage of modifying *Northcutt* (an advantage which Applicants do not admit could even be achieved by modifying *Northcutt* in the manner the Examiner proposes). (Office Action at 7) The alleged advantage cited by the Examiner (facilitating proper management of information) does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants’ invention to modify the particular techniques disclosed in *Northcutt* to include a decision regarding “determining if any of the plurality of messages is associated with a work assignment;” and (2) how one of ordinary skill in the art at the time of Applicants’ invention would have made such a modification to *Northcutt*.

³ The Examiner maintains that Applicants have not adequately traversed the taking of Official Notice and states that Applicants’ arguments on this point are moot because the Examiner has already concluded that the limitations are taken as admitted prior art. (Office Action at 5) Applicants have already documented at length their disagreement with the Examiner on this issue. Applicants understand that the Examiner and Applicants do not agree on this point, and Applicants preserve this argument for Appeal, if necessary.

As Applicants have repeatedly discussed, “it does not even appear that there would be any reason for making such a determination in the system of *Northcutt*.” For example, assume for the sake of argument only (and not by way of concession) that the Examiner is correct that *Northcutt* discloses a dispatcher that is operable to receive a plurality of messages (Office Action at 11, stating that the user in *Northcutt* submits a request for service (RFS) in the form of a message) and that an RFS states an actual task that needs to be performed. There would simply be no reason to modify the system of *Northcutt* to include making a determination as to whether any of the plurality of messages (RFSs) is associated with a work assignment because presumably all of the RFSs would be associated with work assignments. It is unclear why the alleged motivation of “information management” would lead one of ordinary skill in the art at the time of Applicants’ invention to incorporate “a dispatcher operable to . . . determine if any of the plurality of messages is associated with a work assignment” into the system of *Northcutt*. In other words, it is not clear how the alleged advantage of “information management” would even be achieved by modifying the system of *Northcutt* to include such as dispatcher. **The Examiner still claims that some advantage would be achieved (see Office Action at 7), but has not addressed this argument by Applicants.**

To the extent that the Examiner is arguing that one of ordinary skill in the art at the time of Applicants’ invention *could have* modified *Northcutt* to include a dispatcher operable to “determine if any of the plurality of messages is associated with a work assignment, Applicants note that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. ch. 2143.01(III) (emphasis added); see also *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The requirement to show some reason why the modification would have been obvious has been reaffirmed in an official USPTO memorandum dated May 3, 2007 wherein the Deputy Commissioner for Patent Operations pointed to sections of *KSR v. Teleflex*, which recite, “it will be necessary . . . to determine whether there was an *apparent reason* to combine the known elements in the fashion claimed by the patent at issue.”⁴ Applicants submit that the statements made by the Examiner do not

⁴ *KSR Int’l. Co v. Teleflex Inc.*, 550 U.S. ___, 82 U.S.P.Q.2d 1384 (2007) (emphasis added).

provide a supported explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention (*without using Applicants' claims as a guide*) to modify *Northcutt* in the manner proposed by the Examiner; and (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so.

Applicants respectfully submit that the Examiner's attempt to modify *Northcutt* appears to constitute the type of impermissible hindsight reconstruction of Applicants' claims, using Applicants' claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the Examiner has not adequately provided an adequate explanation for modifying *Northcutt* in the manner the Examiner proposes, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicants respectfully submit that the rejection must therefore be withdrawn.

Moreover, at least because *Northcutt* fails to disclose, teach, or suggest a dispatcher operable to "determine if any of the plurality of messages is associated with a work assignment," as recited in Claim 1, *Northcutt* necessarily fails to disclose, teach, or suggest an active work server operable to "receive work information associated with at least one message *determined by the dispatcher to be associated with a work assignment*," "create, in response to receiving the work information associated with at least one message determined by the dispatcher to be associated with a work assignment, a work item associated with the at least one message [*determined by the dispatcher to be associated with a work assignment*]" based at least in part upon the work information associated with at least one message determined by the dispatcher to be associated with a work assignment, wherein the work item comprises an owner identifier," and "communicate the work item [*associated with the at least one message determined by the dispatcher to be associated with a work assignment*] to an owner associated with the owner identifier," as recited in Claim 1.

As to the recitations of “automatically” in Claim 1, the Examiner argues that “merely providing an automated way to replace a well-known activity which accomplishes the same result is not sufficient to distinguish over the prior art,” citing *In re Venner* as support. (See Office Action at 13 citing *In re Venner*, 262 F.2d 91, 95, 120 U.S.P.Q. 193, 194 (C.C.P.A. 1958). *Venner* does not apply to the current application. The Board of Patent Appeals and Interferences (the “Board”) examined the *Venner* decision in 2001. See *Ex Parte Richard Brouillet, Jr.*, 2001 WL 1339914 (Bd. Pat. App. & Inerf. 2001) (copy attached). In *Brouillet* the Examiner had cited *Venner* for a substantially similar proposition for which the Examiner cites *Venner* in this application – that “it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only route in [sic, routine] skill in the art.” *Brouillet*, 2001 WL 1339914, at *2. In declining to apply *Venner* to the facts in *Brouillet*, the Board stated that in *Venner* “all limitations in the claims, including the automatic means, were disclosed in the applied references.” As was the case in *Brouillet*, *Northcutt* fails to disclose, teach, or suggest all of the claim limitations, and as the Examiner has apparently acknowledged, fails to teach automating its steps. (See Office Action at 13) For this reason alone, *Venner* does not apply to the current application.

Moreover, citing Federal Circuit precedent, the Board in *Brouillet* stated that “reliance on per se rules of obviousness is legally incorrect and must cease.” Likewise, Applicants respectfully submit that the Examiner’s reliance on such a *per se* rule in this case is improper. Additionally, as was the case in *Brouillet*, Applicants submit that the Examiner in this case has not established that manually performing the steps purportedly disclosed in *Northcutt* achieves the same result as the automated operations recited in Claim 1. There is simply no basis, particularly in light of the above authority, for the Examiner to take Official Notice that automating the steps of *Northcutt* would have been obvious.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims. For at least certain analogous reasons, Applicants respectfully request reconsideration and allowance of independent Claim 24 and its dependent claims.

B. Discussion of Certain Dependent Claims

Dependent Claims 2-11 and 25-34 depend from independent Claims 1 and 24, respectively, which Applicants have shown above to be clearly allowable over *Northcutt* (even in light of the Examiner's proposed modifications to *Northcutt*). Thus, dependent Claims 2-11 and 25-34 are allowable at least because of they depend from allowable independent claims. Additionally, dependent Claims 2-11 and 25-34 recite further patentable distinctions over *Northcutt*.

As a first example, dependent Claim 10 recites, "The system of Claim 8, wherein the work item further comprises a first link to at least one of the evaluation, the recording, and the survey." To the extent that *Northcutt* discloses any "work item" as recited in Applicants' claims (and Applicants do not concede that it does), nowhere does *Northcutt* disclose, teach, or suggest that the work item "comprises a first link to at least one of the evaluation, the recording, and the survey," as recited in Claim 10. The portion of *Northcutt* cited by the Examiner in rejecting Claim 10 merely discloses that a link is communicated to the owner of an RFS and to the submitter of the RFS, but fails to disclose, teach, or suggest that this link is "to at least one of the evaluation, the recording, and the survey," as recited in Claim 10.

Moreover, Applicants maintain that the Examiner's attempt to dismiss certain of the limitations recited in Claim 10 is improper. "***All words*** in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. ch. 2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (emphasis added). *Northcutt* clearly fails to disclose, teach, or suggest a work item that "comprises a first link to ***at least one of the evaluation, the recording, and the survey***," as recited in Claim 10.

The Examiner argues that *Northcutt* teaches a work item that "comprises a first link to the received message," citing paragraphs 66 and 68 of *Northcutt*. (Office Action at 16) The Examiner acknowledges that *Northcutt* does not teach the specific data to which the links refer in Claim 10 (*i.e.*, at least one of the evaluation, the recording, and the survey); however, the Examiner argues that these limitations only recite non-functional descriptive material and are not functionally involved in the steps recited, nor do they alter the recited structural

elements. (Office Action at 16 referring to Office Action at 7-8, 14)⁵ Applicants respectfully disagree.

Applicants submit that the Examiner's attempt to dismiss these acknowledged distinctions between Claim 10 and *Northcutt* as non-functional descriptive material is improper. Claim 10 positively recites that "the work item further comprises a first link to at least one of the evaluation, the recording, and the survey." This link in Claim 10 distinguishes a work item that does not include a link to at least one of the evaluation, the recording, and the survey. These limitations are not merely a printed matter, ***an issue which is plainly raised through the authority cited by the Examiner.***⁶ The very case cited by the Examiner, (*see* Office Action at 8, 14), supports this position. *See In re Lowry*, 32 F.3d 1579, 1583, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994) (stating that "the printed matter cases have no factual relevance where the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer).

Moreover, assuming for the sake of argument that *Northcutt* discloses a work item that comprises a link (which Applicants do not concede), the link purportedly disclosed in *Northcutt* is not a link to "at least one of the evaluation, the recording, and the survey." Indeed, the cited portions of *Northcutt* fail to disclose any evaluation, recording, or survey. A link to *X* is clearly distinguishable from a link to *Y*. To establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest ***all the claim limitations.***" *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) (emphasis added).

⁵ The Examiner yet again refers to "the recited method steps." (*See* Office Action at 8) Applicants yet again point out that Claims 1-18 are explicitly directed to a system. The system comprises certain elements that are operable to perform certain functionality. Claims 1-18 are not method claims, and the limitations recited in those claims are not method steps.

⁶ In response to the Examiner's "confusion" over the printed matter reference in Applicants' two previous Responses, Applicants again note that the Examiner's citation to *In re Gulack* in his rejection implicates the "printed matter rejections." "Printed matter rejection" is a commonly used term to refer to rejections based on "nonfunctional descriptive material," since the primary examples of such nonfunctional descriptive material are music, literature, art, photographs, and mere arrangements or compilations of facts or data. *See* M.P.E.P. ch. 2106.01. Until the Examiner ceases to rely on a case specifically relating to "printed matter rejections," Applicants are not inclined to discontinue identifying this distinction from the authority cited by the Examiner. The actual content of authority cited by the Examiner is highly relevant to whether that authority supports the proposition for which it is being cited.

The Examiner continues to cite *In re Gulack* and *In re Lowry* as support for the Examiner's position.⁷ Although Applicants do not agree that the above-discussed distinctions constitute nonfunctional descriptive material, one of the very decisions cited by the Examiner states, "Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of printed matter [i.e., nonfunctional descriptive material]. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable." *In re Gulack*, 703 F.2d 1381, 1385, 217 U.S.P.Q. 401, 403 (Fed. Cir. 1983). Applicants respectfully submit that the Examiner has performed such an improper dissection of Applicants' claims in this case.

Moreover, *In re Lowry* provides additional support that all of the limitations recited in Applicants' claims are entitled to patentable weight. The court in *In re Lowry* held that claims directed to data structures stored in a memory define functional characteristics of the memory. *In re Lowry*, 32 F.3d 1579, 1583, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). The link recited in Claim 10 defines a functional relationship to the linked item (e.g., at least one of an evaluation, a recording, and a survey) that allow a user to access the linked item from the work item.

Applicants note that both decisions cited by the Examiner held that the Board of Patent Appeals & Interferences improperly ignored limitations recited in the applicant's claims. See *In re Gulack*, 703 F.2d at 1387, 217 U.S.P.Q. at 405; *In re Lowry*, 32 F.3d at 1584-85. Respectfully, the Examiner makes the same mistake with respect to certain limitations recited in Applicants' claims.

For at least these reasons, Applicants respectfully request reconsideration and

⁷ The Examiner states that "Applicants have failed to even respond to the Examiner's rejection of the limitation on non-functional grounds." (Office Action at 8) Respectfully, this is simply incorrect. Applicants have repeatedly addressed the cases the Examiner cites as purportedly supporting the Examiner's position. Applicants again respectfully submit that the cases do not support the Examiner's position. The Examiner continues to cite those cases, has not responded to Applicants' arguments distinguishing those cases from the present situation, and has not provided any additional authority supporting the Examiner's position.

allowance of dependent Claim 10 and its dependent claims. For at least certain analogous reasons, Applicants respectfully request reconsideration and allowance of dependent Claim 33 and its dependent claims.

As a second example, dependent Claim 11 recites, “The system of Claim 10, wherein the work item further comprises a second link to at least one application used to perform the work assignment.” First, Claim 11 depends from Claim 10, which Applicants have shown above to be allowable, and is allowable for at least this reason. Second, to the extent that *Northcutt* discloses any “work item” as recited in Applicants’ claims (and Applicants do not concede that it does), nowhere does *Northcutt* disclose, teach, or suggest that the work item “comprises a second link to at least one application used to perform the work assignment,” as recited in Claim 11. According to the Examiner, *Northcutt* discloses that “users are provided with an interface enabling them to link to resources and tools to perform modifications or additions to the work assignment.” (Office Action at 8, 16 citing *Northcutt*, ¶¶ 60-63)

Assuming for the sake of argument that the Examiner’s characterization of *Northcutt* is accurate, an interface enabling users to link to resources and tools to perform **modifications or additions to the work assignment** (as allegedly disclosed in *Northcutt*) is distinguishable from a link to at least one application used to **perform** the work assignment,” as recited in Claim 11. According to the Examiner, *Northcutt* “teaches that the second link takes a user to information for instruction and information,” citing paragraphs 60-63. (Office Action at 9) Even if the Examiner’s statement is true, Claim 11 recites that the work item comprises a second link to at least one **application used to perform** the work assignment. The Examiner states that this “information for instruction and information” is “explicitly the same as enabling a user to perform the work assignment.” (Office Action at 9) Applicants reiterate that instruction and information do not disclose, teach, or suggest **an application**, let alone **an application used to perform the work assignment**. Moreover, the cited portions do not appear to disclose, teach, or suggest that any of the instruction or information is used to actually **perform** any work assignment.

Applicants maintain that the discussion at paragraphs 60-63 of *Northcutt* relates to an

interface through which a user can manually create a report. *See* ¶ 60, lines 1-3. The cited portion of *Northcutt* does not discuss a work item created by an active work server, as recited in Claim 1 (from which Claim 8 depends), much less a created work item that “comprises a second link to at least one application used to perform the work assignment,” as recited in Claim 11.

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claim 11 and its dependent claims. For at least certain analogous reasons, Applicants respectfully request reconsideration and allowance of dependent Claim 34 and its dependent claims.

At least certain of the additional dependent claims also recite further patentable distinctions over *Northcutt*. To avoid burdening the record and in view of the clear allowability of independent Claims 1 and 24, Applicants do not specifically discuss these distinctions in this Response. However, Applicants reserve the right to discuss these distinctions in a future Response or on Appeal, if appropriate.

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claims 2-11 and 25-34.

C. Independent Claim 38 is Allowable over *Northcutt*

The Examiner rejects Claim 38 under 35 U.S.C. § 103(a) as being unpatentable over *Northcutt*. Applicants respectfully traverse this rejection.

Applicants maintain that *Northcutt* is unrelated to a call center environment. The Examiner dismisses this distinction as an intended use. Applicants respectfully disagree. The invention recited in Claim 38 is not simply “adapted to a call center environment,” as the Examiner asserts. (Office Action at 9) Instead, Claim 38 positively recites specific limitations that relate to a call center environment – limitations which the Examiner has not located in any reference. For example, Claim 38 recites that the plurality of messages received by the dispatcher “each compris[es] a session summary associated with a session

between a call center representative of the call center and a caller to the call center.” As another example, Claim 38 recites that “a work assignment compris[es] one or more of completing an evaluation of a session, reviewing a recording associated with a session, and reviewing a survey associated with a session.” These are positively-recited limitations that distinguish Applicants’ claims from *Northcutt*.

Applicants maintain that *Northcutt* does not disclose, teach, or suggest a dispatcher operable to “receive a plurality of messages each comprising a session summary associated with a session between a call center representative of the call center and a caller to the call center” and to “automatically determine if any of the plurality of messages is associated with a work assignment, a work assignment comprising one or more of completing an evaluation of a session, reviewing a recording associated with a session, and reviewing a survey associated with a session,” as recited in Claim 38.

Applicants also maintain that, for at least certain reasons analogous to those discussed above with reference to independent Claim 1, *Northcutt* fails to disclose, teach, or suggest an active work server that is operable to: “receive work information associated with at least one message determined automatically by the dispatcher to be associated with a work assignment;” “automatically create a work item associated with the at least one message based at least in part upon the work information, wherein the work item comprises an owner identifier;” and “automatically communicate the work item to an owner associated with the owner identifier for performance of the work assignment associated with the work item.”

For at least these reasons, Applicants respectfully request consideration and allowance of independent Claim 38.

D. Dependent Claims 12-18 and 35-37 are Allowable over the Proposed *Northcutt-Ouchi* Combination

The Examiner rejects Claims 12-18 and 35-37 under 35 U.S.C. § 103(a) as being unpatentable over *Northcutt* in view of U.S. Patent Application Publication No. 2003/0023675 by Ouchi et al. (“*Ouchi*”). Applicants respectfully disagree.

Dependent Claims 12-18 and 35-37 depend from independent Claims 1 and 24, respectively, which Applicants have shown above to be clearly allowable over *Northcutt* (even in light of the Examiner's proposed modifications to *Northcutt*). *Ouchi* fails to make up for at least the deficiencies of *Northcutt* discussed above. Thus, dependent Claims 12-18 and 35-37 are allowable at least because they depend from allowable independent claims. Additionally, dependent Claims 12-18 and 35-37 recite further patentable distinctions over the proposed *Northcutt-Ouchi* combination.

As just one example, dependent Claim 12 recites:

The system of Claim 11, further comprising a collaboration server having a plurality of work folders associated with a plurality of owners and operable to:

retrieve at least one of the evaluation, the recording, or the survey based on the first link; and
launch at least one application based upon the second link.

The proposed *Northcutt-Ouchi* combination fails to disclose, teach, or suggest various limitations recited in Claim 12.⁸

The Examiner refers to the rejection of Claim 10 (which is based solely on *Northcutt*) as the basis for the disclosure of "retriev[ing] at least one of the evaluation, the recording, or the survey based on the first link [the work item comprising the first link and the first link being to at least one of the evaluation, the recording, and the survey]," as recited in Claim 12. (Office Action, Page 19) As discussed above with respect to Claim 10, *Northcutt* fails to disclose, teach, or suggest a work item that comprises a first link to at least one of the evaluation, the recording, and the survey, and the Examiner improperly dismisses certain of

⁸ Applicants maintain that, in rejecting Claim 12, the Examiner appears to read limitations from Applicants' Specification into the claims. (See, e.g., Office Action at 9-10, 18-19) It appears to Applicants that the Examiner specifically limits the claim term "collaboration server" to the example embodiment described in the Specification (see Specification, Page 10). Applicants submit that it is improper to limit Applicants' claims to the specific example embodiments described in the Specification. See, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323-24, 75 U.S.P.Q.2d 1321, 1334-35 (Fed. Cir. 2005). Claim terms should be construed according to their ordinary and customary meaning. In other words, the Examiner is not simply interpreting the limitation "collaboration server" in light of the Specification; the Examiner is specifically limiting the claim term to the example described in the Specification rather than construing the claim term according to its ordinary and customary meaning in light of the Specification.

these limitations as non-functional, descriptive material. Moreover, Claim 12 specifically recites that a collaboration server is operable to *retrieve* at least one of the evaluation, the recording, or the survey based on the first link. *Northcutt* does not disclose, teach, or suggest *retrieving* at least one of the evaluation, the recording, or the survey based on the first link. The Examiner does not allege that *Ouchi* makes up for this deficiency of *Northcutt*.

As another example, the proposed *Northcutt-Ouchi* combination fails to disclose, teach, or suggest “launch[ing] at least one application based upon the second link [the work item comprising the second link and the second link being to at least one application used to perform the work assignment],” as recited in Claim 12. As discussed above with respect to Claim 11, *Northcutt* fails to disclose, teach, or suggest a work item that comprises a second link to at least one application used to perform the work assignment. Therefore, Applicants respectfully submit that *Northcutt* necessarily fails to disclose, teach, or suggest a collaboration server that is operable to “launch at least one application based upon the second link,” as recited in Claim 12. The Examiner does not allege that *Ouchi* makes up for this deficiency of *Northcutt*.

Applicants maintain that the proposed *Northcutt-Ouchi* combination fails to disclose, teach, or suggest all of the limitations recited in Claim 12. “***All words*** in a claim must be considered in judging the patentability of that claim against the prior art.” See M.P.E.P. ch. 2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (emphasis added).

Additionally, Applicants do not admit that the proposed *Northcutt-Ouchi* combination is even possible or that the Examiner has shown the requisite teaching, suggestion, or motivation in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of invention to combine or modify these references in the manner the Examiner proposes.

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claim 12 and its dependent claims.

At least certain of the additional dependent claims also recite further patentable distinctions over the proposed *Northcutt-Ouchi* combination. To avoid burdening the record and in view of the clear allowability of independent Claims 1 and 24, Applicants do not specifically discuss these distinctions in this Response. However, Applicants reserve the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Additionally, Applicants do not admit that the proposed *Northcutt-Ouchi* combination is even possible or that the Examiner has shown the requisite teaching, suggestion, or motivation in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of invention to combine or modify these references in the manner the Examiner proposes.

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claims 12-18 and 35-37.

II. No Waiver

All of Applicants' arguments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the reference cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner's rejections.

Conclusion

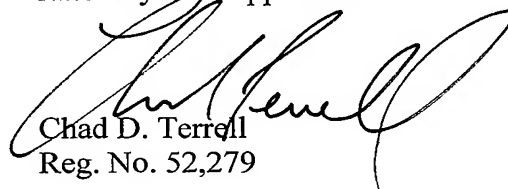
Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicants, at the Examiner's convenience at (214) 953-6813.

The Commissioner is hereby authorized to charge the amount of \$1110.00 for a three-month extension-of-time fee to Deposit Account No. 02-0384 of Baker Botts L.L.P. Although Applicants believe no other fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Date: October 9, 2008

CORRESPONDENCE ADDRESS:

Customer No. 05073

2001 WL 1339914 (Bd.Pat.App. & Interf.)

Board of Patent Appeals and Interferences
Patent and Trademark Office (P.T.O.)

EX PARTE RICHARD BROUILLET, JR.

Appeal No. 1998-2297
Application 08/353,622

HEARD: April 12, 2001

Warren A. Kaplan
Choate, Hall and Stewart
Exchange Place
53 State Street
Boston, MA 02109-2891

Before OWENS, TIMM and DELMENDO
Administrative Patent Judges.
OWENS
Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1, 2, 4-8 and 11. Claims 9 and 10, which are all of the other claims remaining in the application, stand withdrawn from consideration by the examiner as being directed toward a nonelected invention.

THE INVENTION

The appellant claims a method for cleaning a glass surface of a mirror by using a portable, high-speed rotary power tool to rub the surface with a pad having thereon an acidic, abrasive composition. Claim 1 is illustrative:

1. A method for cleaning a glass surface of a mirror, comprising:
 - affixing a pad to a portable, power tool having means for engaging the pad;
 - applying a composition having a pH less than 7.0 and containing an abrasive to the pad;
 - applying the pad to the glass surface;
 - operating the tool in a rotary motion at high speed until the glass surface is clean;
 - and

removing excess composition from the glass surface.

THE REFERENCES

Thomas et al. (Thomas)	5,192,460	Mar. 9, 1993
McLaughlin	WO 84/03459	Sep. 13, 1984

THE REJECTION

Claims 1, 2, 4-8 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over McLaughlin in combination with Thomas.

OPINION

We reverse the aforementioned rejection. We need to address only claim 1, which is the sole independent claim.

McLaughlin discloses "[a] dry glass cleaner in the form of a flexible, porous substrate base which is impregnated with fine particles of a water-insoluble solid which are adapted to disperse the dirt present on a soiled glass surface into a thin, opaque film when the cleaner is moistened and wiped over the glass surface" (abstract). "When the base, which may be in the form of a porous sheet, is wetted and wiped over a glass, ceramic, or other nonporous surface, the water insoluble material is physically transferred to the glass surface where it mixes with the soil to leave a thin, visible film or haze. The film or haze, either in the dry, partially dry, or wet state, is then wiped off the window with an uncoated paper or cloth towel" (page 3, lines 8-15).

Thomas discloses "an acidic microemulsion that can be sprayed onto the surface to be cleaned, and wiped off without usual rinsing, and still will leave the cleaned surface bright and shiny" (col. 1, lines 11-14).

*2 The appellant's claim 1 recites that a pad having thereon an abrasive, acidic composition is affixed to a portable, power tool which is rotated at high speed until the glass surface is clean. During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification, as the claim language would have been read by one of ordinary skill in the art in view of the specification and prior art. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); *In re Herz*, 537 F.2d 549, 551, 190 USPQ 461, 463 (CCPA 1976); *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976); *In re Kroekel*, 504 F.2d 1143, 1146, 183 USPQ 610, 612 (CCPA 1974); *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238-39 (CCPA 1971). The applied prior art does not mention power tools, and the appellant's specification discloses only rotary speeds of about 9,000 to about 13,000 revolutions per minute (specification, page 3, lines 1-2; page 4, lines 14-15). Thus, we interpret "high speed" in the appellant's claim 29 as meaning that the rotary speed is on the order of about 9,000 to about 13,000 revolutions per minute.

The examiner argues (answer, page 4) that "it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine [sic, routine] skill in the art. *In re Venner*, 120 USPQ 192."

In *In re Venner*, 262 F.2d 91, 94, 120 USPQ 192, 194 (CCPA 1958), the appellants argued that "the basis for allowance of the appealed claims [to an apparatus for molding trunk pistons of aluminum and magnesium alloys] resides in the combination of the old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court stated that "it is well settled that it is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity

which has accomplished the same result.” *Venner*, 262 F.2d at 95, 120 USPQ at 194. In *Venner*, however, all limitations in the claims, including the automatic means, were disclosed in the applied references. See *Venner*, 262 F.2d at 96, 120 USPQ at 195.

In the present case, unlike in *Venner*, the examiner has not provided a reference which discloses a high speed rotary power tool, let alone one which is used for cleaning glass. The examiner has merely relied upon a *per se* rule that providing a mechanical or automatic means to replace manual activity which has accomplished the same result is unpatentable. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), “reliance on *per se* rules of obviousness is legally incorrect and must cease.” Moreover, as correctly pointed out by the appellant (brief, pages 4-5), the examiner has not established that manual rubbing accomplishes the same result as a rotary power tool.

*3 The examiner argues that “it would have been obvious for one skilled in the art to use the power tool with certain speed instead of the manual pad to obtain optimum results” (answer, page 6). Both of the references relied upon by the examiner, however, indicate that little rubbing is required to clean surfaces using the disclosed compositions. McLaughlin states that “a dried strip of the film formed by the application of a wetted window cleaner to a glass surface should be completely removable by no more than 5-6 passes, preferably 1-3 passes of a dry paper towel applied to the film at a pressure of about 1 lb./sq. inch, a force which approximates the wiping force applied by an average user to the dried film on a vertical glass surface” (page 10, lines 13-19), and that it is “an object of the present invention to provide a product which minimizes the effort required to clean a glass surface” (page 2). Thomas teaches: “Sometimes, the product may be formulated as an ‘aerosol spray type’, so that its foam discharged from the aerosol container will adhere to the surface to be cleaned. At other times the aqueous medium may be such as to result in a gel or paste, which is deposited on the surface by hand application, preferably with a sponge or cloth, and is removed by a combination of rinsing and wiping, preferably with a sponge, after which it may be left to dry to a shine, or may be dried with a cloth” (col. 10, lines 21-30). Thomas also discloses: “In use, the microemulsion is sprayed onto ‘bathtub ring’ on a bathtub, which also includes lime scale, in addition to soap scum and greasy soil. The rate of application is about 5 ml. per 5 meters of ring (which is about 3 cm. wide). After application and a wait of about two minutes the ring is wiped off with a sponge and is sponged off with water. It is found that the greasy soil, soap scum, and even the lime scale, have been removed effectively. In those cases where the lime scale is particularly thick or adherent a second application may be desirable, but that is not considered to be the norm” (col. 11, lines 19-29). The examiner has not explained, and it is not apparent, why these disclosures of use of little wiping with a paper towel or sponge would have indicated to one of ordinary skill in the art that optimum results would be obtained by rubbing the surface using a high speed rotary power tool.

For the above reasons we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the appellant's claimed invention. Accordingly, we reverse the examiner's rejection.

DECISION

The rejection of claims 1, 2, 4-8 and 11 under 35 U.S.C. § 103 over McLaughlin in combination with Thomas is reversed.

REVERSED

BOARD OF PATENT APPEALS AND INTERFERENCES

*4 TERRY J. OWENS

Administrative Patent Judge

CATHERINE TIMM

Administrative Patent Judge

ROMULO H. DELMENDO

Administrative Patent Judge

2001 WL 1339914 (Bd.Pat.App. & Interf.)
END OF DOCUMENT